

**Notice of Allowability**

Application No.

09/428,122

Examiner

S. Devi, Ph.D.

Applicant(s)

MURDIN ET AL.

Art Unit

1645

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 6/15/04.
2. ☒ The allowed claim(s) ~~is/are~~ 1-4, 10-14, 16, 18, 19, 38, 39 and 42-44, now renumbered as claims 1-4, 5-9, 10, 11, 12, 13, 14 and 15-17 respectively.
3. ☒ The drawings filed on 25 July 2002 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS ( as "replacement sheets" ) must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948 ) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☒ Other See Attachment.

## **ATTACHMENT TO NOTICE OF ALLOWABILITY**

### **Request for Continued Examination**

1) A request for continued examination under 37 C.F.R. 1.114, including the fee set forth in 37 C.F.R. 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. 1.114, and the fee set forth in 37 C.F.R. 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. 1.114. Applicants' submission filed on 06/15/04 has been entered.

### **Applicants' Amendment**

2) Acknowledgment is made of Applicants' amendment filed 06/15/04 in response to the final rejection mailed 01/21/04.

### **Examiner's Amendment**

3) An Examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to Applicants, an amendment may be filed as provided by 37 C.F.R. 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee. The authorization for this Examiner's amendment was provided by Mr. Nicholas Triano III in a telephone interview on 20 August 2004. This application has been amended as indicated below:

- (a) Claims 25 and 26 have been canceled.
- (b) In line 3 of claim 1, the recitation 'SEQ ID NO: 1;' is replaced with --SEQ ID NO: 1 and--.
- (c) In line 2 of part (b) of claim 1, the recitation 'a' is replaced with --the--.
- (d) In line 2 of claim 2, the recitation 'sequence encoding' is replaced with --sequence, wherein the polynucleotide encodes--.
- (e) In line 1 of claim 4, the recitation 'nucleotide' is replaced with the recitation --polynucleotide--.
- (f) In line 1 of claim 12, the recitation 'A' is replaced with --An isolated--.

### **Status of Claims**

4) Claim 1 has been amended via Applicants' amendment filed 06/15/04.  
Claims 25 and 26 have been canceled via this Examiner's amendment.

Claims 1, 2, 4 and 12 have been amended via this Examiner's amendment.

Claims 1-4, 10-14, 16, 18, 19, 38, 39 and 42-44 are pending and are under examination.

### **Rejection(s) Moot**

- 5) The rejection of claims 25 and 26 made in paragraph 15(b) of the Office Action mailed 08/20/03 under 35 U.S.C § 112, second paragraph, as being indefinite, is moot in light of the cancellation of these claims via this Examiner's amendment.
- 6) The rejection of claims 25 and 26 made in paragraph 10 of the Office Action mailed 01/21/04 under 35 U.S.C. § 112, first paragraph, as containing inadequate written description, is moot in light of the cancellation of these claims via this Examiner's amendment.
- 7) The rejection of claims 25 and 26 made in paragraph 11 of the Office Action mailed 01/21/04 under 35 U.S.C § 112, first paragraph, as being non-enabled, is moot in light of the cancellation of these claims via this Examiner's amendment.
- 8) The rejection of claims 25 and 26 made in paragraph 12 of the Office Action mailed 01/21/04 under 35 U.S.C § 102(e)(1) as being anticipated by Knudsen *et al.* (WO 98/58953, already of record), is moot in light of the cancellation of these claims via this Examiner's amendment.

### **Rejection(s) Withdrawn**

- 9) The rejection of claim 1 made in paragraph 15(a) of the Office Action mailed 08/20/03 under 35 U.S.C § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to claim 1.
- 10) The rejection of claims 2-4, 10-14, 16, 18, 19, 38, 39 and 42-44 made in paragraph 15(b) of the Office Action mailed 08/20/03 under 35 U.S.C § 112, second paragraph, as being indefinite, is withdrawn in light of Applicants' amendment to the base claim.
- 11) The rejection of claims 1-4, 10-14, 16, 18, 19, 38, 39 and 42-44 made in paragraph 10 of the Office Action mailed 01/21/04 under 35 U.S.C. § 112, first paragraph, as containing inadequate written description, is withdrawn in light of Applicants' amendment to the base claim.
- 12) The rejection of claims 1-4, 10-14, 16, 18, 19, 38, 39 and 42-44 made in paragraph 11 of the Office Action mailed 01/21/04 under 35 U.S.C § 112, first paragraph, as being non-enabled, is withdrawn in light of Applicants' amendment to the base claim.

**13)** The rejection of claims 1-3, 10-14, 16, 18, 19, 38, 39 and 42 made in paragraph 12 of the Office Action mailed 01/21/04 under 35 U.S.C § 102(a) as being anticipated by Knudsen *et al.* (WO 98/58953, already of record), is withdrawn in light of Applicants' amendment to the claims and/or the base claim. Claim 1, as amended, gets priority to 10/29/98 and Knudsen *et al.* is not applicable now as prior art. The interpretation given below to the polynucleotide claimed in part (b) of claim 1 obviates Knudsen *et al.* as prior art.

**14)** The rejection of claims 42, 43 and 44 made in paragraph 13 of the Office Action mailed 01/21/04 under 35 U.S.C. § 103(a) as being unpatentable over Knudsen *et al.* (WO 98/58953, already of record) in view of Murdin *et al.* (US 6,403,101, already of record), is withdrawn in light of Applicants' amendment to the claims and/or the base claim. Claim 1, as amended, gets priority to 10/29/98 and Knudsen *et al.* is not applicable now as prior art. The interpretation given below to the polynucleotide claimed in part (b) of claim 1 obviates Knudsen *et al.* as prior art.

#### **Claim Interpretation**

**15)** The polynucleotide claimed in part (b) of claim 1 is and must be interpreted in this application as the full length polynucleotide which hybridizes under stringent hybridizing conditions of 6xSSC containing 50% formamide at 42°C with the polynucleotide of comprising the nucleotide sequence of SEQ ID NO: 1.

#### **Remarks**

**16)** Claims 1-4, 10-14, 16, 18, 19, 38, 39 and 42-44 are allowed. Claims 10-14, 16, 18, 19, 38, 39 and 42-44 are now renumbered as claims 5-9, 10, 11, 12, 13, 14 and 15-17 respectively.

**17)** Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center, which receives transmissions 24 hours a day and 7 days a week. The transmission of such papers by facsimile must conform with the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The RightFax number for submission of before-final amendments is (703) 872-9306. The RightFax number for submission of after-final amendments is (703) 872-9307.

**18)** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAG or Public PAIR. Status information for unpublished applications

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is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.Mov>. Should you have questions on access to the Private PAA system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**19)** Any inquiry concerning this communication or earlier communications from the Examiner should be directed to S. Devi, Ph.D., whose telephone number is (571) 272-0854. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 7.15 a.m. to 4.15 p.m. except one day each bi-week, which would be disclosed on the Examiner's voice mail system.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Lynette Smith, can be reached on (571) 272-0864.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

August, 2004

  
S. DEVI, PH.D.  
PRIMARY EXAMINER